UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,408	06/15/2000	Joey L. Erickson	33012/292/101	9110

			EXAMINER
27516	7590	06/22/2004	COLLINS, SCOTT M

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ART UNIT	PAPER NUMBER
2143	9

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/594,408	ERICKSON ET AL.
		Examiner	Art Unit
		Scott M. Collins	2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 April 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-20 examined.

2.   The claim rejections under 35 U.S.C. 112, second paragraph have been withdrawn in light of applicant's amendments.

3.   It is hereby acknowledged that the following papers have been received and placed of record in the file: Request for Continued Examination and Pre-Amendment C on 04/30/2004.

Claim Objections

4.   Claim 4 is objected to because of the following informalities: claim 4 was designated "(Previously presented)" when it should actually have been "(Currently Amended)". Appropriate correction is required.

Response to Arguments

5.   Applicant's arguments, see pages 9-22 of Pre-Amendment C, filed 04/30/2004, with respect to the rejections of the claims under 35 U.S.C. 102 have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, new grounds of rejections are made in view of the same references under 35 U.S.C. 103(a). Though applicant's arguments are now moot in view of the new rejection, the examiner would like to respond to some of the persistent issues.

6.   Regarding the rejections of claims 6-8, 11, 13, 16, 19, applicant again alleges that the common practice of rejecting logically equivalent sets of claims by pointing to the same citation for a different type of invention whose limitations are identical in scope to the first set of claims is an unlawful and factually erroneous practice. If it would assist applicant, the examiner will explicitly point to the same citations in the references for each of the claims 6-8, 11, 13, 16, 19,

but the examiner does not see the purpose in this. The fundamental issue lies in the difference

between an apparatus and a method (or other types of inventions). For anyone who is well

versed in the computer and computer networking arts, it is easy to understand that while a

computer is a physical apparatus, it is also always performing a method by any action it does

(even down to the most basic act of computation).

7.   Another fundamental issue is applicant's term "generic gateway" in the independent

claims. While applicant defines this term in the specification, the claims stand on their own

merit and the specification is not read into the claims (with the exception of 'means plus

function' type claims as applicant discusses). It would be highly advantageous for applicant to

further qualify how a "generic gateway" differs from any standard gateway in the art since the

term "generic gateway" is not common in the art. Further, on page 18, lines 15-16, applicant

argues that "Applicants' [generic gateway], on the other hand, accommodate[s] these differing

formats through the use of a single generic gateway." However, this feature (which appears to

define the invention) is not found in the independent claim being discussed.

8.   Additionally, applicant continually harkens back to MPEP 2111.02 stating that "applicant

may be his or her own lexicographer" whenever the examiner simply uses synonyms for the

claim language to better aid the applicant in understanding the rejection. Standing on the

"lexicographer" quote is clearly erroneous and inconsistent with controlling law because the

examiner is only utilizing words that mean the same thing as applicant's claim language. The

examiner is not attempting to redefine the claim language in any way as applicant repeatedly and

mistakenly accuses.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

10.   Claims 1-3, 6-8, and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Gebauer, U.S. Patent Number 6,370,588 B2 (herein Gebauer) in view of what would have

been obvious to a person of ordinary skill in the art at the time the invention was made.

11.   Referring to claim 1, Gebauer has taught a data processing system having a user terminal

for entering a transaction request, wherein said transaction request has one of a plurality of

protocols, responsively coupled via a publicly available digital communication network to an

enterprise server for responding to said transaction request using an enterprise protocol which is

not one of said plurality of protocols (Gebauer figure 4, requesting client 64, network 84, and

enterprise server 86; and figures 5 and 6 show that the one protocol of a plurality of possible

protocols is HTML.), the improvement comprising a generic gateway interposed between said

user terminal and said enterprise server which responsively couples said user terminal to said

enterprise server by converting said plurality of protocols to said enterprise protocol (Gebauer

figures 3-6, 9, 12 all pertain to a generic gateway interposed between the user and the server.).

12.   Gebauer does not expressly disclose a plurality of protocols (that is, formats or methods

of accomplishing tasks) beyond HTML. MPEP 2144.04-VI-B acknowledges that the duplication

of parts in a system would only have required ordinary skill in the art. Therefore, at the time the

invention was made, it would have been obvious to a person of ordinary skill in the art to use

Gebauer's system to process not only HTML, but other protocols as well. One of ordinary skill in the art would have been motivated to do this in order to create a more efficient system that can be used to process multiple protocols instead of needing separate systems to process each protocol.

13.   Referring to claim 2, Gebauer has taught the improvement further comprising a plurality of adapters interposed between said generic gateway and said user terminal which responsively couples said user terminal to said generic gateway wherein each one of said plurality of adapters corresponds to said one of said plurality of protocols (Gebauer figure 4 and column 8, lines 4-36 where the client's request is adapted to use each service 70 and 72. Also, Gebauer figure 8 and column 12, lines 20-42 show the user's request being adapted based on the type of service.).

14.   Referring to claim 3, Gebauer has taught the improvement wherein said publicly available digital communication network further comprises the Internet (Gebauer figure 9 and column 8, lines 7-12).

15.   Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3 and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

16.   Claims 11 and 16 do not recite limitations above the claimed invention set forth in the combination of claims 1 and 2 and are therefore rejected for the same reasons set forth in the rejection of claims 1 and 2 above.

17.   Referring to claims 12 and 17, Gebauer has taught the method further comprising transferring said converted and processed service request from said generic gateway to an end service provider via a connector (Gebauer figure 4 and column 8, lines 4-36 where the clients request is adapted to use each service 70 and 72. Also, Gebauer figure 8 and column 12, lines

20-42 show the user's request being adapted based on the type of service. In both cases, once the request has been adapted (which is synonymous with the act of converting or processing) it is directed to the actual service provider via the connection between them.).

18.   Claims 13 and 19 do not recite limitations above the claimed invention set forth in claim 3 and are therefore rejected for the same reasons set forth in the rejection of claim 3 above.

19.   Referring to claim 14, Gebauer has taught the method wherein said one of said plurality of formats further comprises an active server page (Gebauer figure 4, elements 70 and 72).

20.   Referring to claim 15, Gebauer has taught the method wherein said one of said plurality of formats further comprises a standard programming language (Gebauer column 8, lines 24-27).

21.   Referring to claim 18, Gebauer has taught an apparatus wherein said one of said plurality of adapters corresponds to said one of said plurality of connectors (Gebauer figure 4 where each adapter corresponds to the connector whereby the adapter is connected to the client.).

22.   Claims 1-3, 6-8, 11-13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen, U.S. Patent Number 5,845,267 (herein referred to as Ronen) in view of what would have been obvious to a person of ordinary skill in the art at the time the invention was made.

23.   Referring to claim 1, Ronen has taught a data processing system having a user terminal for entering a transaction request, wherein said transaction request has one of a plurality of formats, responsively coupled via a publicly available digital communication network to an enterprise server for responding to said transaction request using an enterprise protocol which is not one of said plurality of protocols, the improvement comprising a generic gateway interposed

between said user terminal and said enterprise server which responsively couples said user

terminal to said enterprise server by converting said plurality of protocols to said enterprise

protocol (Ronen figure 1 and column 5, line 43 – column 6, line 9 where transaction server 121

acts as a gateway between user terminal 101 and server 126.).

24.   Ronen has not expressly disclosed a "generic gateway." However, Ronen includes a

transaction server that provides the functionality of a "generic gateway." At the time the

invention was made, it would have been obvious to a person of ordinary skill in the art to utilize

Ronen's transaction server as a generic gateway to translate the protocols of various requests.

One of ordinary skill in the art would have been motivated to do this because Ronen's

transaction server handled all requests to and from the billing platform and if any of the requests

utilized differing formats, the transaction server would have been the most efficient location to

perform the translation.

25.   Referring to claim 2, Ronen has taught the improvement further comprising a plurality of

adapters interposed between said generic gateway and said user terminal which responsively

couples said user terminal to said generic gateway wherein each one of said plurality of adapters

corresponds to said one of said plurality of protocols (Ronen figure 1 and column 5, line 43 –

column 6, line 9 where the adapters are that which adapt the request to be processed by the

server.).

26.   Referring to claim 3, Ronen has taught the improvement wherein said publicly available

digital communication network further comprises the internet (Ronen figure 1 element 104).

27.   Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3

and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

28.   Claims 11 and 16 do not recite limitations above the claimed invention set forth in the

combination of claims 1 and 2 and are therefore rejected for the same reasons set forth in the

rejection of claims 1 and 2 above.

29.   Referring to claims 12 and 17, Ronen has taught the method further comprising

transferring said converted and processed service request from said generic gateway to an end

service provider via a connector (Ronen figure 1 and column 5, line 43 – column 6, line 9 where

the request is passed to the billing server (column 6, lines 10-13).).

30.   Referring to claim 18, Ronen has taught an apparatus wherein said one of said plurality of

adapters corresponds to said one of said plurality of connectors (Ronen figure 1 and column 5,

line 43 – column 6, line 13 where each adapter is located within the transaction server 121 and

corresponds to the connector between the transaction server and the billing server).

31.   Claims 13 and 19 do not recite limitations above the claimed invention set forth in claim

3 and are therefore rejected for the same reasons set forth in the rejection of claim 3 above.

32.   Claims 1-13, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Deisinger et al., U.S. Patent Number 6,397,220 B1 (herein Deisinger) in view of Sheard et al.,

U.S. Patent Number 6,453,356 (herein referred to as Sheard).

33.   Referring to claim 1, Deisinger has taught a data processing system having a user

terminal for entering a transaction request (Deisinger figure 1, client 36), wherein said

transaction request has one of a plurality of formats (Deisinger figure 3, elements 236, 240, 244,

248, 252, 256, 260, 264), responsively coupled via a publicly available digital communication

network to an enterprise server for responding to said transaction request using an enterprise

protocol which is not one of said plurality of protocols (Deisinger figure 1, enterprise server 52).

34.   Deisinger has not expressly disclosed a singular generic gateway through which a

plurality of protocols can be converted. Sheard has taught a gateway that can both input and

output a plurality of formats or protocols (Sheard abstract; figure 1; column 2, line 31 – column

3, line 29; and column 4, line 48 – column 6, line 34). At the time the invention was made, it

would have been obvious to a person of ordinary skill in the art to utilize Sheard's system within

the system of Deisinger. One of ordinary skill in the art would have been motivated to do this in

order to make the system of Deisinger more efficient by utilizing only one generic protocol

gateway in the system rather than multiple separate gateways for each protocol in the system.

35.   Referring to claim 2, Deisinger has taught the improvement further comprising a plurality

of adapters interposed between said generic gateway and said user terminal which responsively

couples said user terminal to said generic gateway wherein each one of said plurality of adapters

corresponds to said one of said plurality of protocols (Deisinger figure 2, element 229 where the

user's request is adapted based on the type of service.).

36.   Referring to claim 3, Deisinger has taught the improvement wherein said publicly

available digital communication network further comprises the internet (Deisinger column 4,

lines 42-43).

37.   Referring to claims 4 and 9, Deisinger has taught the improvement further comprising an

NT Server housing said generic gateway and providing a middleware environment (Deisinger

figures 3 and 4 and column 6, lines 26-32).

38.   Referring to claims 5, 10, and 20, Deisinger has taught the improvement wherein said

user terminal further comprises an industry compatible personal computer operating under a

commercially available operating system (Deisinger column 4, lines 40-46).

39.   Claims 6-8 do not recite limitations above the claimed invention set forth in claims 1-3

and are therefore rejected for the same reasons set forth in the rejection of claims 1-3 above.

40.   Claims 11 and 16 do not recite limitations above the claimed invention set forth in the

combination of claims 1 and 2 and are therefore rejected for the same reasons set forth in the

rejection of claims 1 and 2 above.

41.   Referring to claims 12 and 17, Deisinger has taught the method further comprising

transferring said converted and processed service request from said generic gateway to an end

service provider via a connector (Deisinger figure 2 and column 5, lines 27-51 where the

middleware adapts / converts / processes the requests and routes the it to the correct service

provider via connections 225, 227, etc.).

42.   Claims 13 and 19 do not recite limitations above the claimed invention set forth in claim

3 and are therefore rejected for the same reasons set forth in the rejection of claim 3 above.

43.   Referring to claim 18, Deisinger has taught an apparatus wherein said one of said

plurality of adapters corresponds to said one of said plurality of connectors (Deisinger figure 2

where the adapters in element 229 correspond to the connector (225, 227, etc.) that will route to

the service provider.).

Conclusion

44.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

    a.   Nguyen et al.   U.S. Patent Number 6,304,915

    b.   Farrell et al.   U.S. Patent Number 5,377,191

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Scott M. Collins whose telephone number is 703.305.7865. The

examiner can normally be reached on Mon.-Thurs. 7:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David A Wiley can be reached on 703.308.5221. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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smc
June 7, 2004

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